

REMARKS

In the Office Action mailed May 22, 2008 from the United States Patent and Trademark Office, claims 27-39 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and claims 1-9 and 23-39 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Applicants respectfully provide the following (All references to the specification are made by paragraph number of the published application for the convenience of the Examiner):

Rejections under 35 U.S.C. § 112, First Paragraph (Written Description):

Claims 27-39 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, claim 27 was rejected because support in the specification was not pointed out at the time of submission of the claim for the language “stressing and balancing system” and “stressing and balancing device.” Additionally, claims 28-34 were rejected because support in the specification was not pointed out at the time of submission of the claims for the language “stressing and balancing system.” Although claims 35-39 were listed as rejected, no analysis regarding those claims was found. Applicants therefore respectfully request removal of the rejections of claims 35-39.

Regarding claims 27-34, the specification includes many instances where embodiments of the present invention are discussed with respect to stressing functions and balancing functions. Therefore, Applicants respectfully submit that there is ample support for the rejected language, and respectfully submit that the claims comply with the written description requirement.

Applicants respectfully point to at least the following locations of the specification as filed that provide written description of the rejected claim language:

Paragraph [0015], for example, discusses how one or more malady-specific filters is output, and may create a disturbance to an energy component, cellular component, tissue, organ, or system of the body, causing an imbalanced reading. The system then loads products/remedies that are useful for restoring homeostasis or balance, and the system scans through the products/remedies until one or more is found that removes the underlying disturbance. Thus, paragraph [0015] describes a “stressing and balancing” system/device as claimed. A filter that creates a disturbance clearly creates a stress.

Indeed, the specification makes clear that the current systems/devices stress the system. Specifically, paragraph [0097] clearly indicates that the present systems actually stress the internal functions of the body and measure the response of the entire meridian system to the stress. (Second-to-last sentence.)

Additional paragraphs of the specification describing the claimed language include: paragraph [0121] (products/remedies scanned to find the most appropriate to restore balance), paragraph [0143] (prescription attributes for restoring balance), paragraph [0159] product/remedy filter found to be most useful in restoring balance is broadcast directly to the individual, paragraph [0164] (determination is made as to whether a remedy restores balance), paragraph [0080] (system functions to stress the body with a set of frequencies and to automatically load remedies into system for treatment), paragraph [0081] (system functions to

stress the body and automatically load remedies for the stress), etc. The foregoing is only a small portion of the paragraphs reciting functions related to stressing and balancing.

Applicants note that there is no *in haec verba* requirement for analyzing the written description requirement. (See M.P.E.P. § 2163.) That is to say, there is no requirement that the claim language used match word-for-word the language used in the specification. In this instance, while the phrases “stressing and balancing system” and “stressing and balancing device” are not found together in the specification in that exact wording, the specification as a whole provides ample written description for the claim language used, as is evidenced in part by the above specific citations. Therefore, Applicants respectfully submit that the rejected claim language satisfies the written description requirement, and Applicants respectfully request removal of all written description rejections under 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. § 112, First Paragraph (Enablement):

All claims have been rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement. Applicants respectfully note that the pertinent analysis under the enablement requirement is not whether the field of art is viewed with some skepticism by practitioners of other fields of art (or even whether some within the art have expressed some skepticism regarding certain areas of the art), but whether the disclosure contains sufficient information to enable one skilled in the pertinent art to make and use the claimed invention. The current rejections cite to publications expressing such doubts, but whether such doubts have been expressed or not, the issue is not the disfavor with which some practitioners view electrodermal screening practices and devices, but whether the specification of the application enables practice

of the claimed invention. Applicants respectfully submit that it has not been shown that the claims are not enabled by the specification.

Applicants also respectfully note that the enablement requirement is a requirement to be applied to the claims. Thus, the analysis of whether the enablement requirement has been met is one that is highly dependent on the claims, and that each claim should be separately analyzed for compliance with the enablement requirement. See M.P.E.P. §§ 2164-2164.08(c). Indeed, M.P.E.P. § 2164.04 specifically states that the burden is on the Examiner to establish a reasonable basis for questioning the enablement of each claim rejected. M.P.E.P. § 2164.04 further sets forth that “[Before] any analysis of enablement can occur, it is necessary for the examiner to construe the claims. For terms that are not well-known in the art, or for terms that could have more than one meaning, it is necessary that the examiner select the definition that he/she intends to use when examining the application, based on his/her understanding of what applicant intends it to mean, and explicitly set forth the meaning of the term and the scope of the claim when writing an Office action. See *Genentech v. Wellcome Foundation*, 29 F.3d 1555, 1563-64, 31 USPQ2d 1161, 1167-68 (Fed. Cir. 1994).”

Applicants appreciate the detailed discussion provided in the office action discussing the factors related to undue experimentation. However, the Office Action again fails to comply with the requirements set forth above, and for these reasons, the Office has not satisfied its burden to establish a lack of enablement regarding the rejected claims. Specifically, while the Office Action now includes quotes of phrases from some claims (“meridian linking filter,” “point stabilizing feature,” “malady-specific customized filter,” “product/remedy filter,” “prescription

constraint filter,” “homeopathic remedy filter,” “customized filters,” “meridian linking filter,” “stressing filters,” and “balancing filters”), there is no construction of such claim terms, and no analysis of the claims showing that one of skill in the art would not know how to make or use the claimed invention.

In the last prior response, Applicants showed that one of skill in the art would know how to make and use the invention. Applicants incorporate herein those comments by reference, and refer the Examiner back to those comments. Applicants respectfully note that the bulk of the rejection discusses portions of the specification and that mention is only made of claims 9, 27, 28, 35, and 36. The referred-to claims do not even include all the independent claims, such as claims 1, 2, and 23. Therefore, the Office has clearly failed to meet its burden to show that the claims are not enabled by the specification as filed.

Applicants respectfully request that the Office refuse to allow its determinations in this case to be tainted by the disregard that some persons have expressed in certain publications for the field related to the one in which Applicants practice.

The Office Action repeatedly recited to supposed unpredictability in the art. Applicants note that none of the references cited in the Office Action discuss filters or frequencies as claimed in the current claim set. Therefore, the Office Action has failed to show that any unpredictability or difficulty encountered in some areas of electrodiagnostics leads to problems associated with the currently-claimed invention. Therefore, for at least the foregoing reasons, Applicants respectfully request removal of all lack of enablement rejections under 35 U.S.C. § 112, first paragraph.

CONCLUSION

Applicants submit that no new matter has been added and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 22 day of September, 2008.

Respectfully submitted,



Michael F. Krieger  
Attorney for Applicant  
Registration No. 35,232

KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, UT 84111  
(801) 328-3600